

## REMARKS

### SUMMARY

Reconsideration of the application is respectfully requested.

Claims 1-36 are in the application. Claims 5 and 22-36 have been amended.

Applicant appreciatively acknowledges the Examiner's consideration and acceptance in item 6 on page 2 of the Office Action of the drawings originally filed on July 9, 2001. Moreover, applicant acknowledges the Examiner's receipt and consideration in items 4 and 5 on page 2 of the Office Action of the Oath and Declaration and the Information Disclosure Statement also filed on July 9, 2001.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In "Claim Rejections – 35 USC § 112" item 7 on page 2 of the above-identified Office Action, claims 5, 22-30, and 32-36 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Office Action states that claims 5, 22-30, and 32-36 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that (1) claim 5 recites the limitation of "one or more added sub-menu items"; (2) that claims 22, 23, 25, 26, 28-30, and 32-36 recite the limitation "the sub-menu items"; and (3) that claims 24, 27 and 30 recite the limitation "said resource".

Claim 5 has been amended to reflect the predetermined condition to change the operational visual representation of the menu item from the second state back to the first state is triggered when a user selects "*a predetermined number* of at least one or more *added* sub-menu items" based on the description that the change of the operational visual representation from a first state to a second state was made to indicate that "*new sub-menu items have been*

added to the operational collection of sub-menu items of the menu item” as recited in claim 1. Thus, the change to the operational visual representation is first made upon adding new sub-menu items in claim 1 and changed back to its original state upon selection of “at least one or more” of the added sub-menu items in claim 5.

With respect to claims 22-36, “modification of a visual representation of a menu item” is made when at least one or multiple sub-menu items are either installed, replaced, and/or updated. Similarly, “first resource and/or said second resource” in claims 24, 27, and 30 are selected from executable and media content. Applicant respectfully submit that the Examiner’s suggested corrections have been made and believe that proper antecedent now exist in the amended claims.

Support for these changes may be found in claims 1-4 and 14-17; Figures 2, 3a/b, 4a/b, 5a/b, and 6a/b; and on pages 8-10 (Figure 2), 10-12 (Figures 3a/b), 12-13 (Figures 4a/b), 13-15 (Figures 5a/b), 15-16 (Figures 6a/b) of the specification of the instant application.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. The above-noted changes to the claims are provided solely for clarification or cosmetic reasons. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

In “Claim Rejections – 35 USC § 102” item 10 on page 3 of the above-identified Office Action, claims 1-6 and 8-36 have been rejected as being fully anticipated by U.S. Patent No. 6,314,570 to *Tanigawa, et al.* (hereinafter “TANIGAWA”) under 35 U.S.C. § 102(e). Applicant respectfully traversesapp.

As will be explained below, it is believed that the claims were patentable over **TANIGAWA** in their original form and, therefore, the claims have not been amended to overcome the **TANIGAWA** reference.

To anticipate the instant application, **TANIGAWA** must teach EVERY element of the claim as indicated in MPEP 2131, specifically "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In fact MPEP 2131 clarifies that not only must the claim be expressly or inherently described, but adds that "**The identical invention must be shown in as complete detail as is contained in the ... claim.**" *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(emphasis added).

The **TANIGAWA** reference discloses a data processing apparatus to display a set of document data on a display unit together with an operation menu. The operation menu including operation items related to the set of document data. More specifically, **TANIGAWA** described a TV menu system that in one embodiment provides information about the media event (soccer game) being viewed. Exemplary event information includes among other items team news, league standings, team town, and sponsorship information. The menu system in **TANIGAWA** allows a user to direct movement and selection of menu items via a TV remote controller. Selection in **TANIGAWA** of a menu item includes moving a highlighting block to various desired items in the menu, the highlighted item is considered the "menu item focus" of the viewer. In this way, the document data associated with the "focus" of the user is displayed. **TANIGAWA** does not describe "changing an operation visual representation ... to convey...that new sub-menu items have been added to ... the menu item" as recited in claims 1 and 14. Rather the description of Figure 27 of **TANIGAWA** indicates that:

If the indication was an indication for updating data display, the control unit 2004 judges whether data and a menu are currently being displayed (S2754). **If data and a menu are not being displayed, the processing returns to S2702.** On the other hand,

**when both data and a menu are being displayed, the control unit 2004 gives an indication to the display control unit 2005 to update the display using the data which has the focused menu item as its title (S2756).**

**The display control unit 2005 reads the data which has the focused menu item as its title information from the data storage unit 2001, and has the display unit 2006 update its display using the new data (S2758), before the processing returns to S2702.**

Therefore the update process described in TANIGAWA does not change the “operational visual representation of the menu item” when new sub-menu items have been added as recited in claims 1 and 14 of the instant application. Rather the update process described in TANIGAWA clearly only updates data **currently being displayed**. TANIGAWA clearly indicates that “If data and a menu are not being displayed, the processing returns to S2702.” More specifically, an update in TANIGAWA only occurs, “when both data and a menu are being displayed”.

Even if the item is displayed there is no change made to the “operational visual representation of the menu item” as recited in claims 1 and 14, rather in TANIGAWA “the control unit 2004 gives an indication to the display control unit 2005 to update the display using the data which has the focused menu item as its title (S2756).” The display control unit 2005 of TANIGAWA “reads the data which has the focused menu item as its title information from the data storage unit 2001, and has the display unit 2006 update its display using the new data (S2758), before the processing returns to S2702.” As such, there is no change in the “operational visual representation of the menu item” as recited in claims 1 and 14 of the instant application, only an update of the displayed data information. In fact, if the item is not being displayed in TANIGAWA the returns without any changes at all.

In contrast to TANIGAWA, the present invention calls for changing “an operational visual representation of the menu item from a first state to a second state *to convey to a user of the client device that new sub-menu items have been added to the operational collection*

*of sub-menu items of the menu item*” as recited in claims 1 and 14 of the present invention. More specifically, if sub-menu items have been added, the “operational visual representation” of the menu item is changed to show that new items are available under the menu item.

Clearly, TANIGAWA does not show changing “an operational visual representation of the menu item from a first state to a second state *to convey to a user of the client device that new sub-menu items have been added to the operational collection of sub-menu items of the menu item*” as recited in claims 1 and 14 of the instant application. Similar language is found in independent claims 22, 25, 28, 31, 33, and 35.

In view of the foregoing, the Examiner is requested to withdraw the rejections under 35 U.S.C. § 102(e) in item 10 “Claim Rejections – 35 USC § 102” on page 3 of the above-identified office action and issue a Notice of Allowance.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

In “Claim Rejections – 35 USC § 103” item 12 on page 9 of the above-identified final Office Action, claim 7 has been rejected as being obvious over U.S. Patent No. 6,314,570 to *Tanigawa, et al.* (hereinafter “TANIGAWA”) in view of U.S. Patent Application Publication No. 2002/0080771 to Krumel, et al. (hereinafter “KRUMEL”) under 35 U.S.C. § 103(a). Applicant respectfully traverses.

As discussed above, TANIGAWA fails to teach or suggest “an operational visual representation of the menu item from a first state to a second state *to convey to a user of the client device that new sub-menu items have been added to the operational collection of sub-menu items of the menu item*” as recited in claim 1 of the instant application. Moreover, KRUMEL also fails to teach or suggest “an operational visual representation of the menu item from a first state to a second state *to convey to a user of the client device that new sub-menu items have been added to the operational collection of sub-menu items of the menu item*” as recited in claim 1 of the instant application. Therefore, for at least these

reasons, dependent claim 7 is not obvious and is patentable over the proposed combination of TANIGAWA and KRUMEL.

Furthermore, the proposed combination of TANIGAWA and KRUMEL fail to establish a *prima facie* case of obviousness. In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). In the instant case, the above-identified Office Action has not provided the requisite reason why one of ordinary skill in the art would have been led to modify TANIGAWA or KRUMEL or to combine TANIGAWA's and KRUMEL's teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in TANIGAWA or KRUMEL or from knowledge available to those skilled in the art. Lastly, the above-identified Office Action has not shown all the claim limitations provided through the proposed combination of TANIGAWA and KRUMEL.

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". *In re Bond*, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" *Winner Int'l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis

added; citations omitted); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). There is no “clear and particular” teaching or suggestion in **TANIGAWA** to incorporate the features of **KRUMEL**, and there is no teaching or suggestion in **KRUMEL** to incorporate the features of **TANIGAWA**.

Moreover, the **KRUMEL** reference fails to even mention, let alone disclose “3D computer games” as recited in claim 7. Rather **KRUMEL** shows a method of utilizing a PLD-based network communication protocols for networking common entertainment equipment, such as home video game console systems. Figure 24 of **KRUMEL** and its related description in paragraphs [0183] and [0184] merely illustrate that a variety of devices including handheld video game systems and home game video systems may attach to the PNUT network. There is no discussion of “3D computer games” as recited in claim 7.

Clearly, the proposed combination of **TANIGAWA** and **KRUMEL** does not show a “family of product products is 3D computer games, and each of the program products is a 3D computer game” as recited in claim 7 of the instant application.

In view of the foregoing, the Examiner is requested to withdraw the rejections under 35 U.S.C. § 103(a) in item 12 “Claim Rejections – 35 USC § 103” on page 9 of the above-identified office action and issue a Notice of Allowance.

**PETITION FOR EXTENSION UNDER 37 C.F.R. § 1.136(A)**

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$120.00 in accordance with Section 1.17 is enclosed herewith.

If an additional extension of time is required, petition for the additional extension is herewith made. Any extension fee associated therewith or any other fees that might be due with respect to Sections 1.16 and 1.17 should be charged to the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

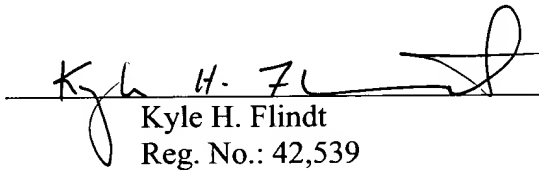
## CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 1-36 are solicited. As a result of the amendments made herein, Applicant submits that claims 1-36 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper or if the Examiner believes patentable language can be worked out, the Examiner is kindly requested to contact the undersigned at (206) 407-1509. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: July 22, 2005

by:

  
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